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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/838,194

04/20/2001

Jeremy P. Clifford

05793.3026-00

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11/17/2006

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EXAMINER

GREIMEL, JOCELYN

ART UNIT

PAPER NUMBER

3693

DATE MAILED: 11/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/838,194

Applicant(s)

CLIFFORD ET AL.

Examiner

Jocelyn W. Greimel

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This Final Rejection is in response to Applicant's Amendments and Remarks filed on August 31, 2006. Claims 1-21 are pending. Claims 1, 6 and 11 are independent claims.

Response to Amendment

1. Applicant's argument regarding:

- (1) "account preference information, describing the applicant's preferences"
- (2) "recommending at least one first financial account product to the applicant based on the received account preference information"
- (3) "further defining predetermined features of the recommended financial account product"
- (4) "customizing a 'recommended product'"

of claims 1-21 have been considered but are found not persuasive. **Claims 1-21 are rejected under 35 U.S.C. 102(e) by Walters et al (US Patent Pub. No. 2002/0143680 A1, hereinafter Walters).**

2. Argument no. (1): Applicant's argue: Walters does not teach: account preference information, describing the applicant's preferences. Response: The Examiner is entitled

to give the claim limitations their broadest reasonable interpretation in light of the Specification (see below):

Claim Interpretation; Broadest Reasonable Interpretation:

<CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION

During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification." Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541, 550-51 (CCPA 1969).>

3. Walters does disclose account preference information, describing the applicant's preferences. **Walters teaches receiving information, which describes the applicant's preferences. This customization information is used to assist in the selection of a financial product and/or financial account. This information can be seen as financial "account preference information."** (Walters: 0011-0018).

Conclusion: Under their broadest reasonable interpretation in light of the Specification, the claims are taught and no inventive concept is found. Applicant's are respectfully requested to point out to the Examiner which claim limitations in the claims are considered to be the inventive concept because the inventive concept can not be determined from the claim limitations as written.

4. Argument no. (2): Applicant's argue: Walters does not disclose recommending at least one first financial account product to the applicant based on the received account

preference information. Response: The Examiner is entitled to give the claim limitations their broadest reasonable interpretation in light of the Specification (see below):

Claim Interpretation; Broadest Reasonable Interpretation:

<CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION

During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification." Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541, 550-51 (CCPA 1969).>

5. Walters does disclose recommending at least one first financial account product to the applicant based on the received account preference information. **As described above, Walters teaches receiving account preference information. Additionally, Walters teaches using this information, which describes the applicant's preferences to recommend a financial account product. Walters is a financial planning method and computer system for assisting financial professionals in determining appropriate financial products for clients** (Walters: abstract; 0005-0025). Conclusion: Under their broadest reasonable interpretation in light of the Specification, the claims are taught and no inventive concept is found. Applicant's are respectfully requested to point out to the Examiner which claim limitations in the claims are considered to be the inventive concept because the inventive concept can not be determined from the claim limitations as written.

6. Argument numbers (3 and 4): Applicant's argue: Walters does not disclose (1) further defining predetermined features of the recommended financial account product and (2) customizing the fin. Response: The Examiner is entitled to give the claim limitations their broadest reasonable interpretation in light of the Specification (see below):

Claim Interpretation; Broadest Reasonable Interpretation:

<CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION

During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification." Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541, 550-51 (CCPA 1969).>

7. Walters does disclose *further* defining predetermined features of the recommended financial account product. **As described above, Walters teaches receiving account preference information. Additionally, Walters teaches using this information, which describes the applicant's preferences to recommend a financial account product. Finally, Walters discloses "subsequent sets of questions" for determining the appropriate financial product.** Subsequent sets of questions mean the questions are further defining the features that were selected using the original questions. (Walters: abstract; 0014). In regard to the customization, Walters describes the subsequent sets of questions being used to select features of the **"available financial products"** – this can be seen as a customization process used on the financial products that were originally recommended for the client. Conclusion:

Under their broadest reasonable interpretation in light of the Specification, the claims are taught and no inventive concept is found. Applicant's are respectfully requested to point out to the Examiner which claim limitations in the claims are considered to be the inventive concept because the inventive concept can not be determined from the claim limitations as written.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. **Claims 16-21 are rejected under 35 U.S.C. 102(e) as anticipated by Walters *supra*.** In reference to claims 16-21, Walters discloses the method, system and computer readable medium for receiving account preference information and selecting

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products. Specifically, Walters discloses receiving various sorts of financial, personal information and financial goal-related information from the client. Claims 16-21 recite types of account preference information and desired features information collected from the client. It is a business choice what specific type of financial, personal and/or goal-related information to collect from the client to use in the selection process.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jocelyn Greimel whose telephone number is (571) 272-3734. The examiner can normally be reached: Monday - Friday 8:30 AM - 4:30 PM EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached at (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jocelyn Greimel
Examiner, Art Unit 3693
November 13, 2006


ELLA COLBERT
PRIMARY EXAMINER